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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte ROGER GILLMAN and DAVID C. WEISS

Appeal 2009-004022
Application 09/801,167
Technology Center 3600

Decided: August 28, 2009

Before, MURRIEL E. CRAWFORD, HUBERT C. LORIN, and JOSEPH A. FISCHETTI, *Administrative Patent Judges*.

FISCHETTI, *Administrative Patent Judge*.

DECISION ON APPEAL

STATEMENT OF THE CASE

Appellants seek our review under 35 U.S.C. § 134 of the Examiner's final rejection of claims 1-8. We have jurisdiction under 35 U.S.C. § 6(b). (2002)

SUMMARY OF DECISION

We AFFIRM.

THE INVENTION

Appellants claim a system and method for networking with people online. (Spec. 1:3-4).

Claim 1, reproduced below, is representative of the subject matter on appeal.

1. A method for providing online networking groups comprising;
entering a first person's profile into a computer database;
entering a second person's profile into said computer database;
comparing said profile and said second profile;
moving said second profile into a second database if said profile and said second profile contain same professions and same areas of practice, creating a networking group contained within said computer database;
creating a networking group contained within said second database;
networking online within a networking group, wherein said networking online includes meeting online.

THE REJECTION

The Examiner relies upon the following as evidence of unpatentability:

Boyd US 2002/0194049 A1 Dec. 19. 2002

Romano, *Meet me in Cyberspace*," Association Management, (Sept. 1998)

The following rejection is before us for review.

The Examiner rejected claims 1-8 under 35 U.S.C. § 103 over Boyd in view of Romano.

ISSUE

Have Appellants shown that the Examiner erred in rejecting claims 1-8 on appeal as being unpatentable under 35 U.S.C. § 103(a) over

Boyd in view of Romano on the grounds that a person with ordinary skill in the art would understand that in Boyd the designed groups would specify diverse professions?

PRINCIPLES OF LAW

"Section 103 forbids issuance of a patent when 'the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains.'" *KSR Int'l Co. v. Teleflex Inc.*, 127 S.Ct. 1727, 1734 (2007). The question of obviousness is resolved on the basis of underlying factual determinations including (1) the scope and content of the prior art, (2) any differences between the claimed subject matter and the prior art, (3) the level of skill in the art, and (4) where in evidence, so-called secondary considerations. *Graham v. John Deere Co.*, 383 U.S. 1, 17-18 (1966). *See also KSR*, 127 S. Ct. at 1734 ("While the sequence of these questions might be reordered in any particular case, the [*Graham*] factors continue to define the inquiry that controls.")

FINDINGS OF FACT

We find the following facts by a preponderance of the evidence:

1. Boyd discloses an inviting user to set "preference and/or criteria of the desired 'guest(s)' (e.g., an attorney, an accountant, a civil war buff, a golfer, a sailor, a New Yorker, a Bostonian, etc.)". (¶[0055]).

2. Boyd discloses a comparing step to determine if an invitee response matches an invite's criteria whereby

> …unacceptable acceptances (e.g., do not match the criteria set forth in the invitation) are screened by the system. More specifically, if the inviting user requested to meet with a resident of a town he is visiting (e.g., to learn about the town), and a user who is not a resident of the town transmits or posts a nonconforming acceptance, the system preferably either screens the improper acceptance (e.g., doesn't allow it to be posted or transmitted to the invitor) or "tags" the acceptance as nonconforming so that the invitor can readily recognize that it is improper and not review it or otherwise respond to it. (¶[0057]).

3. Boyd uses the word "slots" to describe remaining openings in an outstanding invite.(¶[00500])

4. Merriam Webster's Collegiate Dictionary, Tenth Edition, defines slot as: a place or position in an organization or sequence: NICHE.

5. The Examiner found that

> … Boyd does teach negative incentives for a user who does not make invitations or violate invitation rules ([0053, 0073-0075 and 0111]). Because the system would work only if user make as well as honor invitations, it would have been obvious to one of ordinary skill in the art, at the time of the invention, to add to the teachings of Boyd rewards or positive incentives commensurate with the number of invitations/referrals provided by a user." (Para. 18 and 19 of the final rejection Office action mailed on 18 May 2007. Emphasis in the original.)
>
> (Ans. 6).

6. The Examiner further found that "[b]ecause Boyd teaches that the purpose of the reference invention is to make the best use of a user's time ([0006]), it would have been obvious to one of ordinary skill in the art, at the

time of the invention, to add meeting by video/audio conferencing to the teachings of Boyd and Romano." (Ans. 6, 7).

7. Boyd discloses that its networking user terminal 101A is capable of video transmission of a user in that it provides the networking user with an interface to system 100. Among the components of the interface are a video driver and a connected video monitor 310. (¶[0094]).

8. The video driver 304 in Boyd relays received video and text data from CPU 301 to video monitor 310 for display. (¶[0097]). The interface in Boyd also includes a video camera. (¶[0101]).

9. Boyd discloses people networked online in that it

> … relates generally to a computer-based service for enabling individuals to network with other individuals. More specifically, the …method and system … enables a user to use a computer network, such as the Internet, to post an invitation for a meeting such as a dinner meeting and receive acceptances from prospective users interested in accepting the posted invitations. (¶[0044]).

ANALYSIS

We affirm the rejection of claims 1-8.

Appellants do not provide a substantive argument as to the separate patentability of claims 2, 5, 7 and 8 therefore these claims fall with claim 1. *See,* 37 C.F.R. § 41.37(c)(1)(vii)(2004).

Appellants argue that "[t]he present invention teaches a networking group where there is no competition for business among the members of that networking group." (Appeal Br. 10) The Examiner maintains that the argument is outside the scope of the claims (Ans. 5). We agree with the Examiner.

Appellants' arguments "fail from the outset because . . . they are not based on limitations appearing in the claims . . .," and are not commensurate with the broader scope of claim 1 which merely recites the step of *moving said second profile into a second database if said profile and said second profile contain same professions and same areas of practice,* and does not recite a non-compete limitation; nor does the claim restrict the second database from including same profession profiles. *In re Self*, 671 F.2d 1344, 1348 (CCPA 1982).

Appellants next argue that "[c]laim 1 specifically states that a second database is created if a profession and area of practice are duplicated in the first database. Therefore, this goes against the teaching of Boyd." (Appeal Br. 10) We disagree with Appellants because Boyd explicitly teaches a comparing step which, like the limitation at hand, causes an invitee response to be filtered among acceptable acceptances (FF 2). Further, it is unclear from Boyd that all invitation groups are homogeneous as alleged by Appellants given that Boyd discloses "desired guests" of an invitation in the context using the definite article "a" or "an". This suggests that the group being formed would have an acceptable responder from each of the defined categories: an attorney, an accountant, a civil war buff, a golfer, a sailor, a New Yorker, a Bostonian. (FF 1). Taking this interpretation further, we note that Boyd uses of the term "slots" to define each invitee opening. This gives each opening a more unique attribute implying a specialized person because a slot is defined as a place or position in an organization or sequence: NICHE. (FF 4). Based on the totality of the disclosure in Boyd, we find that a person with ordinary skill in the art would conclude that a group could be specified diversely so that one person from each of an attorney, an

accountant, a civil war buff, a golfer, a sailor, a New Yorker, and a Bostonian would be represented. *See KSR Int'l. Co. v. Teleflex Inc.*, 550 U.S. 398, 418 (2007). (In making the obviousness determination one "can take account of the inferences and creative steps that a person of ordinary skill in the art would employ.")

Even if this were not the case, the base concept of filtering an invitee response to meet a given criteria is met by Boyd. (FF 2). Any variance of this criteria is the choice of the organizer as he/she designs the event and thus is not a patentable distinguishing limitation. Therefore, the selection of suitable invitees, such as those having the properties defined in the claims, is no more than a matter of obvious design choice for a person with ordinary skill in the art. *See*, *In re Hopkins*, 342 F.2d 1010, 1015 (CCPA 1965).

Claims 3 and 4 recite providing rewards, points or incentives to said members of said networking group who provide most referrals in the networking group. The Examiner found that Boyd discloses incentives (FF 5), but with negative values. The claims do not limit to positive value incentives, and thus we agree with the Examiner's finding here.

Claim 6 recites networking online with said members via video or audio conferencing; wherein said networking online includes meetings online with said members, said meetings taking place via video or audio conferencing. Appellants assert that "… since there is no teaching at the time of the invention for networking online and creating network groups for online networking, it could not have been obvious to those of skill in reading Boyd to use video/audio conferences." (Appeal Br. 11). We disagree with Appellants. According to Boyd, individuals use a computer network, such as the Internet, to post an invitation for a meeting such as a dinner meeting

and receive acceptances from prospective users interested in accepting the posted invitations. (FF 9). This meets the claim limitations of networking on line. In addition, the system in Boyd is capable of video conferencing (FF 7, 8) and the Examiner found that "[b]ecause Boyd teaches that the purpose of the reference invention is to make the best use of a user's time ([0006]), it would have been obvious to one of ordinary skill in the art, at the time of the invention, to add meeting by video/audio conferencing to the teachings of Boyd and Romano." (FF 6). Thus, the Examiner having established a prima facie case and the Appellants' response being a conclusory statement, the Appellants' argument is not persuasive as to error in the rejection.

CONCLUSIONS OF LAW

We conclude the Appellants have not shown that the Examiner erred in rejecting claims 1-8 under 35 U.S.C. § 103 over Boyd in view of Romano.

DECISION

The decision of the Examiner to reject claims 1-8 is

AFFIRMED.

JRG

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